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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,875	08/04/2003	Hassan M. Fathallah-Shaykh	047940-0148	5251
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FOLEY & LARDNER LLP 150 EAST GILMAN STREET P.O. BOX 1497 MADISON, WI 53701-1497			EXAMINER ZHOU, SHUBO	
			ART UNIT 1631	PAPER NUMBER
			MAIL DATE 03/19/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/633,875

## Applicant(s)

FATHALLAH-SHAYKH, HASSAN M.

## Examiner

Shubo (Joe) Zhou

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12/14/07, 5/29/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 16, 29-35 and 39-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28, 36-38, 43 and 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election***

Applicant's election of Species A in the response filed 12/14/07 is acknowledged.

Applicant's amendments and request for reconsideration filed 5/28/07 and 8/24/07 are acknowledged and the amendments are entered. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

However, given that claim 16 has previously been examined on the merits, it is joined with species A to be examined in the present action.

Accordingly, claims 1-44 are currently pending, among which claims 1-28, 36-38, and 43-44 are under examination; and claims 16, 29-35, and 39-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention or species, there being no allowable generic or linking claim.

Applicant's arguments in response to the previous Office action mailed 2/27/07 have been fully considered but they are not deemed to be fully persuasive. The following rejections and/or objections are either reiterated from the previous Office action or newly applied but necessitated by applicant's amendments, and constitute the complete set presently being applied to the instant application. Rejections and/or objections set forth in the previous Office action but not reiterated herein are hereby withdrawn in view of the amendments and applicant's arguments.

***Claim Rejections-35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-28, 36-38, and 43-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

This rejection is reiterated from the previous Office action mailed 2/27/07.

The claims are drawn to a method for eliminating indistinguishable differentials from a comparison of a pair of samples, comprising: measuring a property of a first sample and a second sample; comparing the measured property of the two samples to identify differences between the measured properties of the two samples; generating a data matrix for each sample; ranking the data points of each matrix from highest to lowest according to intensity such that a plot of rank versus intensity of the data points for each matrix provides an experimental curve for each matrix; fitting a smooth curve to each experimental curve to provide a model curve for each matrix, each model curve comprising a first section separated from a second section by an inflection point; eliminating any pair of corresponding data points for which each data point of the pair is below the inflection point of its model curve; and eliminating any pair of corresponding data points for which the rank of each data point of the pair is below a selected cutoff rank.

The following analysis of facts of this particular patent application follows the rationale suggested in the "Interim Guidelines for Examination of Patent Applications for Patent Subject

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Matter Eligibility" (OG Notices: 22 November 2005, available from the US PTO website at

<http://www.uspto.gov/web/offices/com/sol/og/2005/week47/og200547.htm>).

The Guidelines states:

*To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways (Guidelines, p. 19):*

- *The claimed invention "transforms" an article or physical object to a different state or thing.*
- *The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.*

In the instant case, at least one embodiment of the claimed invention merely manipulates data sequences and performs a series of calculations without transforming an article or physical object to a different state or thing outside a computation device.

Furthermore, the invention does not produce a useful, concrete and tangible result. Specifically, it does not produce a tangible result. Since the process merely manipulates data and performs a series of calculations, and the process can be performed entirely in a computer or machine or human mind without using or making available for use the results of the manipulation to enable its functionality and usefulness to be realized, it does not produce a tangible result.

This rejection could be overcome by amending the claims to include a step of outputting a specific final result to a user. However, applicant is cautioned against introducing new matter to the claims.

Applicant's arguments filed 5/29/07 have been fully considered but they are not persuasive. Applicant first argues that a physical transformation is not required. See page 16 of

the response. This is not disputed as this was cited in the previous Office action and reiterated above: either a physical transformation or producing a useful, concrete and tangible result.

Applicant then argues that the claimed invention produces a useful and concrete results. See bottom paragraph of page 16 and top paragraph of page 17. This is also not disputed because not producing a useful and concrete result is not the basis for the rejection set forth in the previous Office action. Applicant then argues that the claimed invention produces a tangible result because it produces a real world result, which is elimination of indistinguishable differentials from data generated from the comparison of the two samples which results in the removal of unreliable data and providing a more reliable comparison. See page 17 of the response. This is not found persuasive because as set forth above, for at least one embodiment of the claimed invention, the result produced is not used or made available to be used. As such, it cannot be real world if it cannot be used. If the result is outputted or displayed to a user, it would be a real world and tangible result.

### ***Conclusion***

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action, with regard to the new claims. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136

(a). A shortened statutory period for response to this final action is set to expire three months from the date of this action. In the event a first response is filed within two months of the mailing

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date of this final action and the advisory action is not mailed until after the end of the three-month shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136 (a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than six months from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shubo (Joe) Zhou, whose telephone number is 571-272-0724. The examiner can normally be reached Monday-Friday from 8 A.M. to 4 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie Moran, can be reached on 571-272-0720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

/Shubo (Joe) Zhou/

SHUBO (JOE) ZHOU, PH.D.

PRIMARY EXAMINER